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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,495	07/02/2003	Tienteh Chen	200209928-1	4418

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EXAMINER	
SCHWARTZ, PAMELA R	
ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

Office Action Summary	Application No.	Applicant(s)	
	10/613,495	CHEN ET AL.	
	Examiner	Art Unit	
	Pamela R. Schwartz	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election of Group I in the reply filed on 1/7/2005 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP§818.03(a)).

2. The examiner acknowledges receipt and entry of applicants' preliminary amendment filed 8/13/04.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (2003/0186003) for reasons of record and for reasons given below.

Applicants argue that Nakano et al does not teach or suggest the coat weight of the ink receptive layer, but "generally states that a thickness in the range of 10 to 50 micrometers is desirable and goes on to state that the thickness of the ink-receiving layer should be adjusted so that the layer has sufficient absorption capacity to absorb all of the ink applied thereto."

The examiner disagrees with applicants' conclusion that "such general statements do not provide one of ordinary skill in the art sufficient guidance to make the present invention...". In fact, the thickness range set forth the reference, while in microns rather than coating weight, is directly related to the coating weight. One of ordinary skill in the art would find it easy to convert coating thicknesses to coating weights for a given formulation. In addition, the reference sets forth a basis for determining coating weight within the range disclosed. This is well within the scope of one of ordinary skill in the art. Finally, the applicants' coating weights are within those

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normally considered in the art (see for example JP363144076A, JP410138634A, and JP02002248850A which all have coating weights which overlap with applicants' range).

Applicants' assertion that statements such as that of the reference amount to no more than an invitation to experiment are not persuasive in this art since a coating weight must be determined for every ink jet coating, one of ordinary skill in the art has advanced training in chemistry and years of experience in the field, and differences in media properties that are due to differences in coating thickness are well documented in the prior art. The examiner has considered applicants' showings but has not found criticality of applicants' ranges or results that would have been unexpected to one of ordinary skill in the art. If there are particular examples applicants believe patentably distinguish over the prior art, they are invited to point these out and they will be given full consideration.

With respect to the porosity and smoothness of the support, the reference discloses that both coat paper and cast-coated paper may be used. Applicant's specification includes descriptions of such prior art materials that are commercially available. They include many coat papers and cast coat papers that meet the porosity and smoothness requirements of the claims. In fact, all but one of the cast-coated or coated papers described by applicants have smoothness and porosity in the instantly claimed range. Since gloss is important to Nakano et al., it would have been obvious from the disclosure of the reference to use a commercially available coated paper with a high degree of smoothness as its support.

The examiners reliance on resin-covered papers is not misplaced since applicants' claims read on resin-covered papers. While applicants' specification describes porosity of the base paper, the claims do not require the coated base to be porous. Without establishing the criticality of their combination of parameters, applicants are merely reciting known parameters in known ranges (see Example 5 (control) of US 6,291,127, for example, a comparative example representing a "Standard imaging paper" with laminated polyolefin and traditional starch sizing). Gloss and smoothness are highly desirable properties in the art and it would have been obvious to one of ordinary skill in this art to use a commercially available base paper having these recognized properties.

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (2003/0186003) as applied to claim 1, 3 and 4 above, and further in view of Shih et al. (6,780,924) or applicants' admissions at [0014] of the specification for reasons of record and for reasons given below. With respect to cationic superfine colloidal silica, the primary reference discloses silica fine particles and colloidal silica but doesn't give further detail. In such as case, it would have been obvious to one of ordinary skill in the art to look elsewhere in the art for a teaching of a particular silica. Shih et al. is properly relied upon for this purpose.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (2003/0186003) as applied to claims 1-8 above, and further in view of Kaneko et al. (US2001/0004487).

6. Applicant's arguments filed January 7, 2005 have been fully considered but they are not persuasive for reasons set forth above.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz

March 18, 2005



PAMELA R. SCHWARTZ
PRIMARY EXAMINER